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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,713	11/29/2001	Glen Friedman	ISURFTV149	4318

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TODD S. PARKHURST  
HOLLAND & KNIGHT LLP  
131 S. DEARBORN STREET  
30TH FLOOR  
CHICAGO, IL 60603

EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
2173	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/997,713

Applicant(s)

FRIEDMAN ET AL.

Examiner

Raymond J. Bayerl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 9, 12 - 18, 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 9, 12 - 18, 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001, 6 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 – 5, 13 – 17 are rejected under 35 USC 103(a) as being unpatentable over Gupta et al. (“Gupta”; US #6,546,405 B2) in view of Boreczky et al. (“Boreczky”; US #6,366,296 B1).

As per independent claim 1’s “method” in which an “annotation file” is created for “a multimedia presentation”, Gupta’s ANNOTATING TEMPORALLY-DIMENSIONED MULTIMEDIA CONTENT is achieved when A human viewing temporally-dimensioned content will annotate, comment upon, and augment the multimedia document (Abstract). Thus, “identifying at least one desired portion” occurs (see also col 2, lines 13 – 35). The resulting annotation entry 300 records “at least one pointer corresponding to the at least one desired portion” (col 10, line 65 – col 11, line 35), in an annotation collection 420 (the claimed “annotation file”; see also figs 3, 4).

As per “using the at least one pointer for automatically presenting only the one or more portions of the multimedia presentation”, Gupta’s multimedia document player (col 2, lines 36 – 48) is one in which a user can select a temporal annotation from a list, at which point the multimedia document player immediately proceeds to the presentation of the multimedia document at the particular relative time (col 2, lines 48 – 64). In this immediate procession, Gupta is “automatically” performing the function of going to the particular relative time, showing only what is annotated at that time from programming playback, and “eliminating any other portions of the multimedia presentation” than those desired.

Further in claim 1, “automatically identifying at least one desired portion of a multimedia presentation” is accomplished “by user’s equipment”. The Examiner will concede that Gupta’s ANNOTATING is identically disclosed as requiring A human’s input to determine the “desired portion”, and that Gupta does not **explicitly** teach that such an action is “automatically” performed “by user’s equipment”.

Also in claim 1, “automatically presenting only the one or more portions...without displaying the annotations” does not appear to be an **explicit** part of Gupta, where an ongoing display will typically present the annotations with the material retrieved.

However, both of these shortcomings are remedied in Boreczky, where automatic detection of desirable portions of a “multimedia presentation” are used in a MEDIA BROWSER USING MULTIMODAL ANALYSIS, with a resulting display of only playback content, as per the playback region of Boreczky that is shown without annotating content as well.

In Boreczky, Features in a media file...are preferably automatically time-wise evaluated in the media file (Abstract). In the user computing environment Boreczky shows in fig 13, a mapping module 115 can automatically generate metadata values for all of the selectable features (col 11, lines 52 – 63), so that “automatically identifying” is accomplished “by user’s equipment”.

Further in Boreczky, the closest to an illustration of the actual annotations are timeline indicators, but these are not part of the media playback window. Of course, a similar line of reasoning might also be advanced for Gupta, where the media display is not directly incorporated with the annotations that might appear at another location. The

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media playback regions in such systems as this provide a non-annotation-containing presentation.

It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention that the annotation collection developed by Gupta for multimedia be obtained by automatically considering the media as per Boreczky, and then presented in an ordinary media display region with no annotations supplied there, so as to alleviate the need for Gupta's human input and make a more substantial set of Features available for user access, with the overall result of producing a more-desirable uncluttered view of the media. Motivation lies at least in Gupta, where the goal is to build as comprehensive a set of annotations as is possible, and this would be directly facilitated with the Boreczky teachings of machine-generated metadata.

As per claims 2, 9, Gupta's multimedia document player is capable of "creating" and "playing the recorded program file", so that "only the at least one desired portion" appears, to the exclusion of others.

The application of "a predetermined set of criteria" in "identifying at least one desired portion" (claims 3, 14) is seen in Gupta, where The user can select temporal annotations which satisfy various criteria for inclusion in the display of the multimedia document (col 2, lines 48 – 54), these being "based upon a preference of an individual viewer" (claims 4, 15), such as a particular date. Boreczky echoes this capability of implementing user desire, when the user preferably selects at least one feature of the media file using the media feature selection 4 (col 11, lines 34 – 51).

Claim 5's "annotation file" that "further contains: information related to the at least one desired portion" (see also claims 12, 16, 20) reads upon the annotation in Gupta holding additional information, relative to the multimedia document, as in the inclusion of user authored content in content field 310 of a Gupta temporal annotation entry 30 (col 4, lines 52 – 63).

Independent claim 13's "recorded program file" reads upon Gupta's storage of the original Multimedia document 140, which can alternatively be a motion video or audio file (col 4, lines 28 – 51). In handling the collection 420, Gupta uses "an annotation measurement software" so that "a display device displays only the at least one desired portion".

Though claim 13's "annotation file" is "automatically created...without user intervention", which is not directly taught in Gupta, Boreczky provides such a teaching, as noted above.

The overall collection 420 in Gupta will have "information related to a portion...other than the at least one desired portion" (claim 17), since annotations to portions other than those satisfying criteria are included.

3. Claims 6 – 9, 12, 18, 20 are rejected under 35 USC 103(a) as being unpatentable over Gupta in view of Kelly et al. ("Kelly"; US #5,907,322 A) and Boreczky.

As per independent claim 6's "broadcasting an event to a first location" and "simultaneously identifying at least one desired portion of the event at a location remote from said first location", Gupta does not contain **explicit** teachings of such a mode of transmission, being more concerned with what happens at the site of the multimedia

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document player itself, and a similar problem exists with the player environment of Boreczky.

However, Kelly's TELEVISION EVENT MARKING SYSTEM allows for bookmarking viewer selected TV broadcast events (Abstract), and storing a set of event-identifier data associated with the set of selected broadcast events (see also col 1, lines 54 – 67). Kelly further teaches that an activity table of viewer selection information is transmitted to an on-line database (col 1, lines 54 – 67), this being at a “location remote from” the viewer site.

It would have been further obvious to the person having ordinary skill to employ Boreczky's permitting of an “annotation file” to be “simultaneously” performed relative to the “broadcasting”, where such “broadcasting” involves, as in Kelly, “transmitting to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event” for selective playback as per Gupta, so as to increase the range of options in obtaining and accessing a variety of different annotations for content being seen.

Kelly's bookmarking follows the selected broadcast event, and is thus the “annotation file” is “transmitted subsequent to the event” (claim 7).

Independent claim 8 is similar to claim 2 as treated above, and is suggested by Gupta's “creating an annotation file” used in rendering “only one or more desired portions”, and without distracting metadata also in the display region, as seen at least in Boreczky. The “first” and “second transmission medium” are suggested by Kelly, where annotating information is sourced at a separate location from “a multimedia viewing system”, as in Kelly's database origination of user-specific information.

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4. Applicant's arguments filed 27 February 2007 have been fully considered but they are not persuasive.

Applicant's basic argument is that because "annotations" "are not displayed" in the invention as is now claimed, that patentable distinction is being made over Gupta, which the Examiner had previously acknowledged as also displaying the annotations with the media.

However, and upon a new consideration, the Examiner notes in particular how Boreczky's media player has a display region for "presenting only the one or more portions...and without displaying the annotations", as one would expect in a setting where one would not want an obscured view of the media content at such a time. Also, given such a possible interpretation of "without displaying the annotations", even a reference like Gupta appears to have potential in suggesting the claim.

In brief, applicant apparently continues to seek an impermissible "reading in" of limitations to the claims, and in particular, to "without displaying".


5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Raymond J. Bayerl, whose telephone number is (571) 272-4045. The Examiner can normally be reached on M – Th from 9:00 AM to 4:00 PM ET.

6. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kristine Kincaid, can be reached at 571-272-4063. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (571) 273-8300.



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7. Any inquiry of a general nature or relating to the status of this application of proceeding should be directed to the receptionist, whose telephone number is (571) 272-2100.



RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

12 March 2007